became effectual on delivery, and which required nothing to be done on the other side to make it operative. This view appears to have been adopted by the Commissioner of Stamp Duties in giving his ruling.

Applying the above principles, the courts have held the following documents were not promissory notes for the purpose of stamp duty legislation:

(1) An instrument which read: "I, J.H. Dawe, promise to pay Mr. Yeo, on his signing the lease of the Castle Inn, Plymouth, the sum of £150 – J.H. DAWE" – *Yeo* v. *Dawe.*[6]

(2) An instrument issued by a company incorporated under the Joint Stock Companies Acts, 1856 and 1862, purporting upon the face of it to be a "debenture," with coupons for the payment of interest half-yearly attached to it, and containing an engagement on the part of the company to pay "the amount of this indenture" to A.B. or order on a given day, with interest at 5%.

(3) An instrument which read: "In consideration of the agent's forbearance to sue, and of the fact that I shall not be registered as a defaulter ... I hereby undertake to pay the sum of £17.9.9 by July 9, 1908, and to make immediate arrangements with regard to the balance of £550." – *Hodgkins* v. *Simpson.*[8]

(4) An instrument which read: "Reference A.C.3 T.R./W.L.I.S. Kischner, London W.C.1. We confirm herewith that we undertake to pay you irrevocably the sum of £200 to you or into your banking account in respect of the above reference, on April 30, 1935." – *Wirth* v. *Weigel Leygonie & Co. Ltd.*[3]

There are many more decisions in the law reports which show that the mere presence of a promise to pay in an instrument does not stamp that instrument with the character of a promissory note as defined in the Act. I would include the Deed in the present case as amongst this category of instruments which are not promissory notes under the Act. The Deed is an acknowledgment of the defendant's liability for the balance of a mortgage debt and how it was arrived at. It was given for the purpose of carrying out a prior agreement between the parties – see *Yeo* v. *Dawe.*[6] It refers to other matters in addition to the promise to pay. It was executed by both parties and not a unilateral promise by the defendant. It was not intended as a promissory note and it certainly did not look like a promissory note.

The appeal was therefore dismissed with costs.

Appeal dismissed.

Solicitors: *Lim Ganesh & Liu; Advani Hoo, Morris & Kumar.*

RE ARNOLD D. PALMER IN THE MATTER OF TRADE MARK REGISTRATION NO. 63249

[O.C.J. (Chan Sek Keong J.C.) November 27, 1986]

[Singapore – Originating Motion No. 18 of 1986]

Trade Marks – Register – Rectification – Application for – Whether applicant had bona fide intention to use trade mark – Trading interest – Whether aggrieved person – Trade Marks Act (Cap. 206), s.40.

Trade Marks – "Trafficking" – Meaning of – Trade Marks Act (Cap. 206), s.40.

On July 15, 1980, the applicant applied to the Registrar of Trade Marks, Singapore to rectify the Register of Trade Marks by removing therefrom Trade Mark No. 63249 registered in the name of Lim Mok Hui, Ang Lee Kim and Lim Ley Trading as Hui Cheng Dress Makers in Singapore. The mark consisted solely of a device of an umbrella and was registered in Class 25 in respect of shirts, dresses, pyjamas, shorts and T-shirts.

The application was made under section 40 of Trade Marks Act (Cap. 206) in response to the Registrar's refusal, because of the existence on the register of TM 63249, to proceed with the applicant's earlier application to register a trade mark consisting of an umbrella device in respect of all goods included in Class 25, including shirts, sweaters, slacks, jeans, jackets, rain proof clothing, headgear, stockings and socks.

The two issues before the Registrar were: (1) whether the applicant was a person aggrieved under section 40(1) of the Trade Marks Act, and (2) whether TM 63249 ought to be removed from the Register on the ground of non-user under section 40(1)(a) or (b).

The Registrar found that the applicant was not a person aggrieved within the meaning of section 40(1) of the Trade Marks Act as he was not engaged in the same trade as the respondents. Neither had he established how he may be damaged or injured if the trade mark TM 63249 was allowed to stand. The applicant filed this originating motion seeking to reverse the decision of the Registrar.

Held: (1) the applicant must show that he has used his trade mark in the course of a trade which is the same as or

similar to that of the respondents or that he has a genuine and present intention to use the mark as a trade mark. However, the evidence in this case showed none of these things;

(2) section 40 of the Trade Marks Act gives effect to the policy of the legislature that trade marks which remain on the register and not used for a prescribed period of time should not be allowed to remain on the register if they affect the rights of other merchants in the same trade to use these marks or similar marks. It does not create a principle of law that the applicant, to register a mark, is entitled to the prescribed period to decide whether he would use the mark;

(3) the registration of a trade mark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trade mark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary *locus standi* on the applicant for the purpose of rectifying proceedings;

(4) the applicant had failed to prove that he was an aggrieved person and his application was dismissed with costs.

Cases referred to:

(1) *Powell's Trade Mark* (1893) 10 R.P.C. 195.
(2) *Powell's Trade Mark* (1894) 11 R.P.C. 7; [1894] A.C. 8.
(3) *Wright Crossley* v. *Company's Trade Mark* (1898) 15 R.P.C. 379.
(4) *Oscar Trade Mark* [1979] R.P.C. 173, 184.
(5) *Lever Bros.* v. *Sunniwite Products* (1949) 66 R.P.C. 84.
(6) *Consort Trade Mark* [1980] R.P.C. 160.
(7) *Wells Fargo Trade Mark* [1977] R.P.C. 503.
(8) *"Pussy Galore" Trade Mark* [1967] R.P.C. 265.
(9) *Batt's Trade Marks* [1898] 2 Ch. 432.
(10) *Zonophone Registered Trade Mark* (1903) 20 R.P.C. 450.
(11) *Molyslip Trade Marks* [1978] R.P.C. 211.
(12) *Bostitch Trade Mark* [1963] R.P.C. 183.
(13) *Re American Greetings Corp's Application* [1984] 1 All E.R. 426.

ORIGINATING MOTION.

Dedar Singh for the applicant.

Phang Sin Kat for the respondent.

Cur. Adv. Vult.

Chan Sek Keong J.C.: On July 15, 1980, the well-known golfer, Arnold D. Palmer ("the applicant"), made an application ("the application") to the Registrar of Trade Marks, Singapore ("the Registrar") to rectify the Register of Trade Marks by removing therefrom Trade Mark No. 63249 ("TM 63249") registered in the name of Lim Mok Hui, Ang Lee Kim and Lim Ley trading as Hui Ching Dress Makers of 246A Geylang Square, Block 5, Singapore 14. The mark consists solely of a device of an umbrella and is registered in Class 25 in respect of shirts, dresses, pyjamas, shorts and T-shirts for ladies and children and pyjamas for gents. The application was made under section 40 of the Trade Marks Act (Cap. 206) ("the Act") in response to the Registrar's refusal, because of the existence on the register of TM 63249, to proceed with the applicant's earlier application (No. 79133) to register a trade mark consisting of an umbrella device in respect of all goods included in Class 25, including shirts, sweaters, slacks, jeans, jackets, articles of rainproof clothing, headgear (for wear), stockings and socks (for wear).

In the application, the applicant says that he is an aggrieved person, and that the respondents registered TM 63249 without any *bona fide* intention to use it and there had been in fact no *bona fide* use of it in the manner as required by section 40(1)(a) or (b) of the Trade Marks Act (Cap. 206). In the Statement of Case, the applicant, *inter alia*, says that he has a *bona fide* intention to use the trade mark consisting of an umbrella device in respect of goods in Class 25 in Singapore and that by reason of the existence on the Trade Marks Register of TM 63249 he is an aggrieved person.

The applicant filed two statutory declarations in support of the application. In his declaration, sworn on November 6, 1981, Jules Rosenthal ("JR") says the following:

"1. I am the Senior Vice-President of Arnold Palmer Enterprises (hereinafter called 'My Company') of One Erieview Plaza, Cleveland, Ohio 44144, United States of America and have been with My Company for the past 15 years.

2. My Company has been formed to manufacture, distribute and sell goods bearing the trade mark ARNOLD PALMER and UMBRELLA device belonging to Mr Arnold D Palmer, an American Citizen of Suit 1300, One Erieview Plaza, Cleveland, Ohio, United States of America, the Applicant for rectification of the trade mark registration No. 63249. I have been authorised by My Company and Mr. Arnold D Palmer to make this Declaration.

3. The information contained in this Declaration is from my personal knowledge and where necessary obtained by reference to the records of My Company.

4. The Applicant has applied for registration of the trade mark consisting of an Umbrella Device as shown below under application No. 79133 in respect of all goods included in Class 25 including shirts, sweaters, slacks, jeans, jackets, articles of rainproof clothing, headgear (for wear), stockings and socks (for wear).

5. The Applicant is the owner of the trade mark consisting of the umbrella device and started using the said mark on articles of clothing from 1960 in United States of America. The umbrella device has by long user and extensive promotions become identified with goods originating from the Applicant.

6. The Applicant has a United Kingdom registration for the aforesaid mark under No. 899127 dated September 7th, 1966 in Class 25 in respect of 'shirts, sweaters, slacks, shorts, jackets, articles of rainproof clothing, headgear (for wear), stockings and socks (for wear).' I attach hereto and marked 'A', a photocopy of the United Kingdom Certificate of Registration and the renewal certificate.

7. The Registrar of Trade Marks has cited trade mark No. 63249 against the Applicants' application to register his umbrella device under application No. 79133.

8. I have been informed by the applicant's licensees in Singapore, Messrs Yangtzekiang Garment Manufacturing Co Pte Ltd of No. 8, New Industrial Road, Singapore 1953, that although the proprietors of the registration No. 63249 do manufacture garments, the mark registered under No. 63249 does not appear to have been used by the Respondents on their goods."

For convenience, I will hereinafter refer to (i) the mark referred to in paragraph 5 of JR's statutory declaration as the US trade mark, (ii) the mark that is registered in the United Kingdom as the UK trade mark, and (iii) Arnold Palmer Enterprises as "Enterprises." It should be noted that the UK trade mark is not exactly the same as the US trade mark which appears to consist of the umbrella device and the name ARNOLD PALMER, but neither counsel has referred to this difference in their submissions.

The other statutory declaration is that of Khoo Kong Chye ("KKC"), sworn on October 3, 1981, and he says:

"1. I am the Sales Manager of Yangtzekiang Garment Manufacturing Co Pte Ltd (hereinafter called 'My Company') of 8, New Industrial Road, Singapore 1953 and have been with My Company for the past four years.

2. I have been authorised by My Company to make this Declaration and the information contained in this Declaration is from my personal knowledge.

3. My Company is the local trade representative of Arnold Palmer Enterprises of One Erieview Plaza, Cleveland, Ohio 44114, United States of America. My Company sells goods bearing the trade mark of Arnold Palmer and the umbrella device.

4. I am aware that Mr. Arnold Palmer applied for registration of the umbrella device mark under application No. 79133 in Class 25 and objection has been taken to the said application on the ground of registration No. 63249 for a similar umbrella device ..."

The respondents' Counter-Statement states that they are the proprietors of TM 63249 and that since its registration on January 31, 1975, they have been and still are *bona fide* manufacturers and suppliers of articles in respect of which the trade mark is registered to leading firms in Singapore for export in the name and style of the umbrella brand. The respondents have also filed three other affidavits made by representatives of three different firms in Singapore, each asserting that his firm has sold or manufactured the respondents' goods under the respondents' trade mark.

The two issues before the Registrar were: (1) whether the applicant was a person aggrieved under section 40(1) of the Trade Marks Act (Cap. 206), and (2) whether TM63249 ought to be removed from the Register on the ground of non-user under section 40(1)(a) or section 40(1)(b). No oral evidence was called and the application was decided on the said affidavits.

The findings of the Registrar are set out in the following paragraphs of her Grounds of Decision:

"25. The evidence tendered does not show the applicant to be in the same trade as the Respondent. Neither is there evidence to show that he manufactures or deals in the same class of goods to which the registered mark applies. Possession of a UK registration per se does not make the applicant an aggrieved person within the meaning of section 40(1) of the Trade Marks Act as the existence of a trademark in the UK register of trademarks does not prove its user. Neither is it evidence of use. Further his UK registration carries a condition that the specification of goods are not for export to and sale in Malaysia.

26. Counsel for the Applicant referred to the case, *Powell's TM* [1894] AC 8 and submitted that the expression 'person aggrieved' must be construed liberally to include any persons who are in some way or other substantially interested in having the mark removed from the Register, or persons who would be substantially damaged if the mark remained. I do agree with him that the expression 'person aggrieved' should be so construed but I am not prepared to include in this category a person who is a mere possessor of an overseas registration for a similar or identical trademark.

28. Aside from the alleged use of the applicant's UK registration by Arnold Palmer Enterprises I find that there has been no evidence of trading or dealing in the same class of goods by the applicant himself. Nothing has been adduced to show his relationship with Arnold Palmer Enterprises. Though Mr. Jules Rosenthal mentioned in paragraph 5 of his Statutory Declaration that the applicant started using his own mark in USA from 1960, there is no documentary evidence to support trading by the applicant. Further nowhere in the evidence did the applicant indicate that he is engaged in any form of trading. The mere act of making an application to register a trade mark will not confer a *locus standi* upon an applicant for rectification.

31. I therefore find that the applicant is not a person aggrieved within the meaning of section 40(1) of the Trade Marks Act as he is not engaged in the same trade as the Respondents. Neither has he established how he may be damaged or injured if the trade mark TM 63249 is allowed to stand.

32. As the preliminary essential has not been satisfied, I will not proceed to deal with the second issue."

By this Notice of Originating Motion, the applicant seeks to reverse the decision of the Registrar on the grounds (1) that she erred in fact in finding that the applicant was not engaged in the same trade as the respondents; (2) that she erred in law in holding that the applicant had not established how he would be damaged or injured if Trade Mark No. 63249 was allowed to stand, manufactured or dealt in the same class of goods to which the registered trade mark applied, contrary to paragraphs 2, 5 and 8 of JR's Statutory Declaration and paragraph 3 of KKC's Statutory Declaration; (3) that the existence of a trade mark on the United Kingdom Register of Trade Marks did not prove its user and that a person who was a mere possessor of an overseas registration for a similar or identical trade mark was not an aggrieved person. Two of the grounds of appeal were filed *i.e.* (a) the Registrar was wrong in relying on the qualifying condition to the UK trade mark that the goods bearing the trade mark were not for export to and sale in Malaysia as evidence that the said mark had not been used in Singapore and (b) she was wrong in relying on the discrepancy between JR's statement that YZK was the applicant's licensees in Singapore and KKC's statement that YZK was the trade representative of Enterprises when it was irrelevant for the purposes of the rectification proceedings.

Counsel for the applicant submitted that his client was an aggrieved person in that he was "in some way or other substantially interested in having the mark removed from the Register or would be substantially damaged if the mark remained" – see *Kerly's* Law of Trade Marks 11th ed., para 11-07. Now, if this statement represents the law, counsel would have a point because the fact that the applicant, being the owner of two similar trade marks, one in the United States and the other in the United Kingdom, has found himself unable to register one of these marks in Singapore by reason of the existence of TM 63249 must result in substantial damage to him. But that is not the law. The passage from *Kerly* is in substance that of Bowen L.J. in the Court of Appeal in *Powell's Trade Mark*[1] at p.201, lines 25 to 29. When the case reached the House of Lords[2] Lord Herschell said at page 8:

"Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and whenever the trade mark, if remaining on the register would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me that he has a *locus standi* to be heard as a person aggrieved."

and Lord Watson said at page 8:

"In my opinion, any trader is, in the sense of the statute, 'aggrieved' whenever the registration of a particular trade mark operates in restraint of what would otherwise have been his legal rights. Whatever benefit is gained by registration must entail a corresponding disadvantage upon a trader who might possibly have had occasion to use the mark in the course of his business. It is implied, of course, that the person aggrieved must manufacture or deal in the same class of goods to which the registered mark applies, and that there shall be a reasonable possibility of his finding occasion to use it."

Even then, the two speeches quoted above did not attract the unqualified approbation of subsequent judges. In *Wright Crossley & Company's Trade Mark*[3] at page 379, Rigby L.J. pointed out that the judgments did not amount to an assertion that the mere fact that a person is engaged in the same trade was sufficient to make him an aggrieved person. "A fortiori, when a person is not engaged in the same trade or in any trade at all": see *Oscar Trade Mark*[4] at page 184. This view of the law is supported by at least three later decisions, *viz.*, *Lever Bros.* v. *Sunniwite Products,*[5] *Consort Trade Mark*[6] and *Wells Fargo Trade Mark.*[7]

In *Lever Bros,*[5] Romer J. held that a trader whose sole activity lay in the region of soapless detergents could not be regarded as aggrieved in respect of another's mark being on the register in relation to perfumery, cosmetics, preparations for the hair and dentifrices, he having held that none of these registered goods was of the same description as soapless detergents.

In *Consort,*[6] it was held that an applicant for rectification does not have the necessary status of a person aggrieved in respect of goods within the registered proprietors' registration that are not the same or at least of the same description as those in which he is either already engaged in trade or has that fixed intention of use which is a necessary prerequisite to his own application for registration.

In *Wells Fargo,*[7] it was held that whether the parties were trade rivals was to be judged in the context of the business carried on in the United Kingdom by the applicants in relation to trade of manufacturing or dealing in goods for which the mark was registered. As there was no evidence that the applicants in fact so traded with the United Kingdom they were not, therefore, "persons aggrieved."

On the basis of these decisions, it is plain that the applicant will fail in this appeal unless he can show that he has used his trade mark in the course of a trade which is the same as or similar to that of the respondents or that he has a genuine and present intention to use the mark as a trade mark. But the evidence shows none of these things, as the Registrar has found. Not only is there no evidence of trading by the applicant after the establishment of Enterprises either in the United States or the United Kingdom or Singapore, the evidence does not even support the position that Enterprises has traded in Singapore, whatever the relationship may be between the applicant and Enterprises, of which again there is no evidence. I say this because KKC has merely stated that YZK has sold goods for Enterprises but not where the goods were sold. I am not prepared to infer from the statement that the sale took place in Singapore where I can take judicial notice that many garment manufacturers manufacture for export and not for domestic sale.

Counsel for the applicant was then constrained to argue that on the evidence that Enterprises was established to manufacture, distribute and sell goods bearing the applicant's trade mark and has in fact used such trade mark in the course of its trade, it may be inferred that the applicant has been using his mark as a trade mark through Enterprises as an agent, or a licensee. I am not disposed to make such an inference in favour of the applicant for reasons which I shall give later.

Counsel for the applicant then advanced three further arguments on the resumption of hearing of this application.

The first argument was that the applicant having filed Application No. 79133 to register his trade mark has *ipso facto* an intention to use a trade mark, and alternatively, by reason of section 40 of the Act, he need not have a present intention to use the mark so long as he has a future intention to use it within the prescribed period and that will suffice to give him the *locus standi.* In my view, the first argument has no substance whatever. Section 11 allows any person who *claims* to be the proprietor of a trade mark used or proposed to be used to apply to register it. It does not follow that by making an application to register the mark, the applicant has *ipso facto* made out his claim to have used it or an intention to use it as a trade mark. In *"Pussy Galore" Trade Mark,*[8] a company associated with the late Ian Fleming and his widow sought to register under section 17(1) of the Trade Marks Act, 1938 (*in pari materia* with section 11(1) of the Act) as trade marks in respect of a wide variety of goods, the words *"Pussy Galore"* and a number of other marks derived from the fictional characters of Ian Fleming's novels. It was their intention to exploit these trade marks by licensing them on the basis of registered user agreements, although they had made no application to register any third party as a registered user at the time of the applications. The Registrar refused the application on the ground that the applicants did not possess the necessary qualifications of the registered proprietors of a trade mark, since, at the time of application, they had neither an intention to use the mark themselves nor had they applied under section 29(1)(b) to make another party, by whom they intended the mark to be used, a registered user. An appeal to the Board of Trade was dismissed for the reasons given by the Registrar. At page 267, G.W. Tookey, Q.C. sitting on the Board of Trade said:

> "There is a further point. 'Proposed' in the context of section 17(1) must mean that the applicant has a firm intention to use. This point has been established in a number of cases decided under Trade Mark Acts earlier than that at present in force but none the less authoritative. It will suffice if I merely mention *John Batt & Co.* v. *Dunnett* (1899) 16 RPC 411, and *Ducker's Trade Mark* (1928) 45 RPC 397. The applicants, as I understand, admit that at the time of making the application in suit, they intended to use their best endeavours to find others who would use the mark, under suitable control, eventually as registered users. There was therefore no intention to use the mark, but only the intention to seek out others who would be prepared to do so and this speculative element in my view deprives the applicant's intentions of that firmness which is necessary to satisfy section 17(1)."

I cannot state the underlying basis for this principle more clearly than in the words of Romer J. in *Batt's Trade Marks*[9] at page 436 where his Lordship said:

> "I take it to be clear that if persons register new trade-marks, which they say they intend to use, they must, at the date of registration, have a *bona fide* intention of using those trade-marks in respect of the goods for which they register them. Cotton L.J. pointed that out very clearly in the case of *Edwards* v. *Dennis,* when he said: 'Even if a trade-mark can be registered which is not in

actual use' (and, I may add, which has since been used) 'it ought to be restricted to those goods in connection with which it is going to be used'; and, indeed, one cannot help seeing the evils that may result from allowing trade-marks to be registered broadcast, if I may use the expression, there being no real intention of using them, or only an intention possibly of using them in respect of a few articles. The inconvenience it occasions, the cost it occasions, is very large, and beyond that I cannot help seeing that it would lead in some cases to absolute oppression, and to persons using the position they have obtained as registered owners of trade-marks (which are not really *bona fide* trade-marks) for the purpose of trafficking in them and using them as a weapon to obtain money from subsequent persons who may want to use *bona fide* trade-marks in respect of some classes in respect of which they find those bogus trade-marks registered. Indeed, it appears from the evidence of several experts that a system of trafficking in trade-marks appears to be carried on at the present day."

I also reject the related argument based on section 40 of the Act. This provision gives effect to the policy of the legislature that trade marks which remain on the register and not used for a prescribed period of time should not be allowed to remain on the register if they affect the rights of other merchants in the same trade to use these marks or similar marks. It does not create a principle of law that the applicant to register a mark is entitled to the prescribed period to decide whether he would use the mark.

The second argument was that any person who applies to rectify the register of trade marks in consequence of the citation of a conflicting mark against his application to register his trade mark is, by virtue of such citation, an aggrieved person; reference was made to certain statements in the following text books as follows:

(1) *Shanahan,* Australian Trade Marks Law & Practice, 1982, at page 197 n.16 ("An applicant for registration will generally have sufficient standing where he has been threatened with an infringement action or even passing off proceedings based on the mark in question, or where the registration has been cited against his application for registration, whether by the Registrar or by some opponent.");

(2) *Fox,* Canadian Law of Trade Mark & Unfair Competition, 3rd ed. at page 304 n.81 ("a person whose application to register a trade mark has been refused on the ground of the prior registration of the mark sought to be expunged ... is a person aggrieved");

(3) *Narayana,* Trade Marks & Passing Off, 2nd ed. para 866 n.28a ("If an application to register a trade mark is refused on the ground of conflict with a registered trade mark, the applicant is a person aggrieved for the purpose of rectification of that registered mark");

(4) 48 *Halsbury's* Laws of England, 4th edn., para. 866;

(5) *A. Michaels,* A Practical Guide to Trade Marks, 1982, at page 65, n. 23 ("Alternatively, *locus standi* may be established if the applicant has trade mark applications pending for the same description of goods, actual use of the applicant's own mark on those goods is not necessary (indeed, it would render him liable for infringement of the prior mark)").

Counsel for the applicant has taken me through the facts of the authorities relied upon. In my view, none of these cases supports the proposition of law advanced by counsel for the applicant as in every one of them, the facts clearly showed that each of these applicants who had conflicting marks cited against their applications to register were in the same trade and had either used or had intended to use the marks sought to be registered. Nevertheless, I should, of course, test the validity of the proposition against first principles. The registration of a trade mark in the name of a proprietor, once effected, ought not to be disturbed by persons who have no trading interest in the goods concerned. If an applicant for rectification has no such interest to begin with, and therefore cannot suffer any damage at all by the existence of a conflicting trade mark on the register, it cannot be right, in principle, that the mere filing of his application can confer the necessary *locus standi* on the applicant for the purpose of rectifying proceedings. Otherwise, the test of grievance propounded in *Powell's Trade Mark*[2] would be completely nullified by resorting to the simple expediency of applying to register the very mark the applicant seeks to expunge. That was disallowed in *Consort Trade Mark.*[6] Although that is not a citation case, the principle is the same. Accordingly, I do not accept the argument of counsel for the applicant on this point.

In the course of his argument, counsel for the applicant also referred to and relied on *Zonophone Registered Trade Mark*[10] where Byrne J. held that the applicant who was interested in the existing trade mark but who was very likely to make some application for registration as soon as they have got rid of the existing registration was an

aggrieved person. This passage has been quoted out of context. In that case, the applicant, who was engaged in the same trade, had used or evinced an intention to use the mark in question. The applicant, who has adduced no evidence to use or intention to use his mark as a trade mark, can derive no assistance from this case.

The third argument was that since the law does require a user agreement to be registered in order to render it valid (and counsel cited *Molyslip Trade Mark*[11] to support his proposition), the Registrar was wrong in holding that the applicant had not used his mark in that manner as, on the evidence, he could or must have such an agreement with Enterprises. I do not accept this argument for two reasons.

First, the statement from *Molyslip Trade Mark* was again quoted out of context. In that case, the registered proprietors of the mark "Molyslip" were themselves carrying on a trade and using the mark at the same time as the applicants. The applicants, to whom were granted rights to use the same trade mark, applied to rectify the register on the ground that the proprietor had permitted the mark to be used in such a manner as to render it no longer distinctive of their goods. The proprietor had objected to the *locus standi* of the applicants on many grounds, one of which was that the applicants were not registered users. It was held, following Lloyd-Jacob J. in *Bostitch Trade Mark*[12] at 195, that section 28 of the Trade Marks Act 1938 does not make registration of a user agreement mandatory. This statement does not assist the applicant as he himself has not carried on any trade or any intention to do so in respect of goods under his trade mark.

Secondly, the onus on the applicant to prove that he is an aggrieved person cannot be discharged by drawing an inference from the nebulous relationship between the applicant and Enterprises. The fact of Enterprises using or having used the applicant's trade mark does not by itself necessarily prove that the applicant has any trading interest in the goods manufactured or sold by Enterprises. If anything, that fact may indeed give rise to a diametrically opposite but equally valid inference, which is that of trafficking in trade marks.

The Trade Marks Act 1938, by section 28 (*in pari materia* with section 29 of the Trade Marks Act (Cap. 206), relaxed the rule against the assignment and licensing of trade marks, a facility for a person to register a trade mark to be used by others as "registered user" provided that trafficking in trade marks is not thereby facilitated. In *Re American Greetings Corp's Application*[13] the House of Lords held that:

> " 'trafficking in a trade mark' meant dealing in a trade mark primarily as a commodity in its own right rather than for the purpose of identifying or promoting merchandise in which the proprietor of the mark was interested. If there was no real trade connection between the proprietor of the mark and the licensee of his goods, the registrar was entitled to conclude that the grant of the licence to use the trade mark to promote the licensee's goods amounted to trafficking in the mark. Whether a sufficient trade connection existed was a question of fact and degree in every case, but in any case even provision for quality control by the proprietor of the mark over the goods of the licensee was not in itself sufficient to establish the required connection."

Counsel for the applicant, however, contended that an application to register one trade mark does not make the applicant a trafficker as trafficking implies the exploitation of a series of marks. This submission has no substance whatever. What is prohibited is trafficking and not the business of trafficking. In any case, the applicant has already registered two trade marks in other countries in respect of which he has not shown or disposed to show any user of them in relation to any trade he may have. Be that as it may, and because the issue is not the substantive issue before me, it may be unjust to the applicant if I were to find that he has been trafficking in a trade mark, and so, I eschew from doing so. According, I confine my finding to that of the applicant having failed to prove that he is an aggrieved person.

In the result, this application is dismissed with costs.

Application dismissed.

Solicitors: *Drew & Napier; Phang & Co.*